



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/533,514

01/23/2006

Linzhao Cheng

JHU1910-5

4565

28213 7590 09/17/2009

DLA PIPER LLP (US)
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

EXAMINER

CROUCH, DEBORAH

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

09/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/533,514</p>	<p>Applicant(s) CHENG, LINZHAO</p>	
	<p>Examiner Deborah Crouch</p>	<p>Art Unit 1632</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. § 103, claims 17, 26, 27, 29 and 30.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 29 and 30.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-28 and 52-56.
- Claim(s) withdrawn from consideration: 24-51 and 57-64.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Deborah Crouch/
Primary Examiner, Art Unit 1632

Continuation of 3. NOTE: the term "diploid karyotype, " the adult human feeder cells comprise human fibroblasts from breast skin" have not been previously considered or searched.

Continuation of 11. does NOT place the application in condition for allowance because:

Bongso (claims 1-9) - Applicant argues Bongso does not teach human ES cells that are passaged 4 or higher and 2) have a diploid karyotype. Applicant argues Bongso provides no teachings with regard to the culturing of undifferentiated, diploid hES cells through multiple passages. These arguments are not persuasive as no structural difference has been identified to distinguish the hES cells of Bongso from those claimed. The hES cells of Bongso and those of the claims have the same origin, a human blastocyst. Thus as Bongo's cells and the claimed cells have the same origin, they reasonably would be expected to have the same structure. There is no evidence of record or in the art that provides a distinction. While Bongso's cells died prior to multiple passages as claimed, this is not an indication of a structural difference between Bongo's cells and those of the claims. At least no such structural difference has been pointed out. The early death of Bongso's cells could be attributed to other reasons than a structural difference.

Xu (claims 52, 54 and 55) - Applicant's arguments are not persuasive as they are directed to non-entered claim amendments.

Mitalipova (103, claims 10-16 and 52-56) - Applicant's arguments are not persuasive as they are directed to non-entered claim amendments.

Mitalipova and McIntosh - The argument states claims 1, 4, 15, 17 and 20, but no such rejection is of record in the final office action mailed May 7, 2009. There had been a rejection of these claims over Xu and MacIntosh, but the rejection was withdrawn in the final office action. The rejection is claims 10-28 over Mitalipova and McIntosh. Applicant argues the ordinary artisan would not have been motivated to use breast skin fibroblasts given the teachings of Xu regarding conditioned media prepared from fibroblasts being ineffective in maintaining hES cell pluripotency. This argument is not persuasive as Mitalipova teaches successful culture of hES cells on various human fibroblasts, and also teaches using conditioned media prepared from the human fibroblasts. Since the amendments have not been entered, the combination of Mitalipova and McIntosh is sufficient for the claims of record. Further since Mitalipov showed successful culture of undifferentiated hES cells using several human fibroblasts from different tissue sources, the reasonable expectation of success requirement for 103 would have been fulfilled in the addition of McIntosh.